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| 09/692,747      | 10/18/2000  | Craig L. Ogg         | 39478/RRT/S850      | 7075             |

23363 7590 02/25/2004

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| EXAMINER |
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HEWITT II, CALVIN L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/692,747

Applicant(s)

OGG ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4-7</u> . | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-45 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 and 29-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1 and 29 recite the limitation "a second computer used by the user". However, the Applicant did not specifically recite how the second computer is used. Therefore, it is not clear what the Applicant is specifically claiming.

Claims 2-15 and 30-36 are also rejected as they depend from claims 1 and 29, respectively.

b. Claim 13 recites the following language "wherein the VBI bears postage value" (claims 14 and 15 recite similar language). However, claim 1 from which claim 13 depends only refers to a VBI within the confines of the preamble. Specifically, claim 1 does not recite steps or limitations for manipulating or

transforming a VBI. Hence, the Applicant has not distinctly claimed Applicant's invention with regards to claims 13-15.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 3, 8, 11, 13-16, 25-29, 37 and 43-45 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Brookner, U.S. Patent No. 6,041, 317.

As per claims 1, 2, 3, 8, 11, 13-16, 25-29, 37 and 43-45, Brookner teaches a postage security system, utilizing a PSD, that comprises a user using one or more computers, a secret key for identifying a first computer and registering a user, a remote server system that communicates with one or more of computers and receives user information and a secret key for registering a user (i.e. registering a user with an online system), a user that uses said first computer for

second and subsequent communications with the remote system, and stores the secret key as part of a PSD package (abstract; figures 1 and 2; column 2, lines 18-34; column 3, lines 5-12 and 44-67; column 4, lines 1-13 and 23-38).

As per claims 13-15, 26-28, 34-36 and 43-45, Brookner teach a PSD that generates postal indicia (VBI), hence, it is inherent that a VBI (e.g. postage value, ticket or voucher) is printed.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, U.S. Patent No. 6,009,177.

As per claims 1-5, 7-19, 21-31, 33-30 and 41-45Sudia teaches a digital communications security system comprising:

- a user using one or more computers (column 1, lines 20-58; column 2, lines 55-63; column 13, lines 30-63; column 16, lines 9-34; column 21, lines 15-53)
- a secret key for identifying a first computer and registering a user

- a remote system that communicates with one or more user computers and receives user information and a secret key for registering a user (i.e. registering a user with an online system) (column/line 17/29-18/11)
- a user that uses said first computer for second and subsequent communications with the remote system (column 21, lines 15-53)
- a secret key that comprises an encrypted randomly generated hash message authentication key that is generated at the time of registration (column/line 17/50-18/11; column 25, lines 27-51)
- a secret key that comprises an encrypted randomly generated hash message authentication key for digitally signing electronic communications thereby authenticating the user, storing said key at the user computer and changing said key at periodic intervals (column 15, lines 45-58; column 17, lines 37-48 and 55-64; column 21, lines 40-54; column 41, lines 15-43)

Sudia teaches a user computer sending an encrypted secret key to the remote system that decrypts and stores the secret key (column/line 17/50-18/11).

Sudia does not explicitly recite the type of keys used by the remote system to perform such a function. However, as Sudia recites symmetric key encryption (shared key), encryption using session keys, asymmetric encryption (public/private or secret keys used for decryption/encryption or

encryption/decryption), the specific methods of Diffie-Hellman, RSA, Micali, DES, etc. It would have been at least obvious for one of ordinary skill to choose any of the disclosed methods by Sudia to enable to parties to communicate cryptographically.

Limitations identifying the type of VBI used or system with which a user is registering is merely non-functional descriptive material and, non-functional descriptive material cannot render non-obvious an invention that would have been otherwise been obvious (In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Regarding postal security devices, the teachings of Sudia are broadly applied to trusted devices that comprise an embedded microprocessor, input-output interface, memory and optionally a cryptographic co-processor (column 13, lines 30-63). A PSD is an element of the set of "trusted devices" as it comprises the features identified above. In addition, PSD's print "value bearing instruments" (VBI). Therefore, it would have been obvious to one of ordinary skill to apply the teachings of Sudia to trusted devices such as PSDs.

Sudia does not explicitly recite user computers communicating with a system that is a server system. However, Sudia teaches a user first computer communicating with another user computer (column 21, lines 27-29), securing digital communications (column 2, lines 55-63) and distributed data processing systems such as those used for distributing electronic mail (column 1, lines 20-

40), hence, it is at least obvious to one of ordinary skill for the user computer to communicate with the escrow agent computer system (i.e. remote system) over computer network (figures 15 and 16) such as the internet.

8. Claims 6, 20, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, U.S. Patent No. 6,009,177 in view of Ote et al., U.S. Patent No. 6,023,506.

As per claims 6, 20, 32, and 40, Sudia teaches a digital communications security system that uses encryption keys for encrypted user computer specific information such as a secret key comprising an encrypted randomly generated hash message authentication key that is generated at the time of registration (column/line 17/50-18/11; column 25, lines 27-51). However, Sudia does not explicitly recite a specific encryption method for encrypting the user computer specific information. Ote et al. teach a method for generating an encryption key using a user pass-phrase (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Sudia and Ote et al. in order to reduce the burden on users regarding the management of encrypting information ('506, column/line 1/65-2/6).

9. Claims 9, 13-15, 26-28, 34-36 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookner, U.S. Patent No. 6,041,317.



As per claims 9, Brookner teaches a postage security system, utilizing a PSD, that comprises a user using one or more computers, a secret key for identifying a first computer and registering a user, a remote server system that communicates with one or more of computers and receives user information and a secret key for registering a user (i.e. registering a user with an online system), a user that uses said first computer for second and subsequent communications with the remote system, and stores the secret key as part of a PSD package (abstract; figures 1 and 2; column 2, lines 18-34; column 3, lines 5-12 and 44-67; column 4, lines 1-13 and 23-38). Brookner doesn't explicitly recite periodically changing a secret key comprising a hash authentication message. However, Brookner teaches that keys can be "selectively updated" therefore, to one of ordinary skill, the prior art at least suggests the periodical changing of keys (column 4, lines 18-23).

As per claims 13-15, 26-28, 34-36 and 43-45, limitations identifying the type of VBI used or system with which a user is registering is merely non-functional descriptive material and, non-functional descriptive material cannot render non-obvious an invention that would have been otherwise been obvious (In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Clark teaches a method for securing PC transmissions over a network
- Heiden teaches a system for printing coupons using a PSD

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

Art Unit: 3621

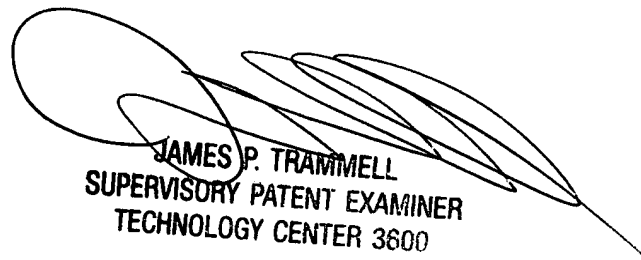
(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

Calvin Loyd Hewitt II

February 20, 2004



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600